



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,621	07/24/2001	J. Michael Milliorn	P02164US0	5460

26271 7590 06/27/2003

FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER

AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
----------	--------------

1772

DATE MAILED: 06/27/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/912,621	Applicant(s) MILLIORN ET AL.	
	Examiner Walter B Aughenbaugh	Art Unit 1772	

--The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

THE REPLY FILED 11 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Attached Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-7,9,10,12-18,21 and 23.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

ADVISORY ACTION

Acknowledgement of Applicant's Amendments

1. The amendments made in claims 1 and 15 given on pages 2 and 4 of Applicant's Amendment (Paper #8) have not been entered due to the fact that the amendment to claim 15 raises new issues that would require further consideration and/or search. The amendment to claim 15 raises new issues that would require further consideration and/or search because the added limitation "wherein the adhesive layer entirely covers the side of the face material adjacent the liner" further limits the scope of claim 15 relative to the scope of claim 15 as finally rejected.

ANSWERS TO APPLICANTS ARGUMENTS

2. Applicant's arguments in Paper #8 regarding the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper #5 and repeated in Paper #7 have been fully considered but are not persuasive.

Applicant's argument on page 6 of Paper #8 that "claim 1 as amended is patentable" is moot since the amendments made in Paper #8 have not been entered.

Applicant's assertion that "Warther teaches away from making triangular-shaped tags" (page 6 of Paper #8) is false. The tags taught by Warther and shown in Figure 3 (tag elements 50A-50X, col. 3, lines 33-41) are triangular shaped tags as made of record in paragraph 10 on pages 5-6 of Paper #5.

Applicant's arguments that "nor are the label portions taught or suggested as being cut prior to applying the PSA and the release paper, just scored" and "nor does [Oosterlinck] teach or suggest a scoring step" on page 7 of Paper #8 and all subsequent arguments that rely upon method limitations are irrelevant because the method of forming the label is not germane to the

Art Unit: 1772

issue of patentability of the label itself. The determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

Applicant's assertion that "the shaped tags of Warther are not formed from a face web, an adhesive layer and a backing/release layer" on page 8 of Paper #8 is incorrect. The laminate of the core (item 12) and transparent layers (items 20 and 22) corresponds to the "face web", magnetizable strips (items 31-34) correspond to the "backing/release layer" and the magnetizable strips (items 31-34) are applied to a transparent layer (item 20 or 22) with an adhesive as taught by Warther (col. 9, lines 50-51) that corresponds to the "adhesive layer". Applicant's argument that the shaped tags of Warther "are [not] cut from a face web to form separate labels as required by Oosterlinck: Warther only teaches scoring sheets" is irrelevant since the method of forming the label is not germane to the issue of patentability of the label itself. The determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113.

Warther teaches that the tags have magnetizable strips applied to the tag face via an adhesive as discussed in the previous paragraph. The tags, by virtue of the fact that they include an adhesive layer and are applied to the magnetizable strips, are labels. Furthermore, the magnetizable strip is a backing layer. As previously made of record on page 7 of Paper #7, the

Art Unit: 1772

printable material/adhesive layer/backing layer structure is clearly established in both Oosterlinck and Warther. As previously made of record on page 6 of Paper #7, Oosterlinck and Warther both teach the same structure of a printable sheet material adjacent to an adhesive layer, and as such one of ordinary skill in the art would have been motivated to have combined the references. Applicant's argument that one skilled in the art would not attempt to combine the teachings in the references because "Warther's scored sheets would then become a cutout label" on page 8 of Paper #8 is not a valid argument because Warther's tags (Examiner interprets the phrase "scored sheets" to refer to the tags of Warther- the entire sheet of Warther would certainly "never become a cutout label") are, as they stand alone, "cutout label[s]" - the scoring allows the tags (equivalently labels as discussed above) to be "cut[]out". Applicant's argument that one skilled in the art would not attempt to combine the teachings in the references because "Oosterlinck would be required to prepare a scored sheet product" on page 8 of Paper #8 is not correct because one of ordinary skill in the art is amply motivated to consult Warther as to how to maximize the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41); the means by which each individual label is removed from the sheet which carries the labels (cutting the labels in the case of Oosterlinck or removing the labels along the scoring of Warther) are both notoriously well known means by which individual labels are removed from the sheet which carries the labels as taught by each of the respective references. Contrary to Applicant's argument that "the function of both references would be destroyed in the proposed combination", both references ultimately teach the same function, removal of labels from a carrier sheet;

Art Unit: 1772

therefore, the “function of both references” is not “destroyed in the proposed combination” because both references in actuality share the same function.

In response to Applicant’s argument that since “Warther considers triangle shapes as difficult to remove from a scored sheet”, “one of ordinary skill [would not] look to this reference for guidance into making a triangular-shaped label” on page 9 of Paper #8, this teaching does not supercede Warther’s teaching of maximizing the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41) by arranging triangular-shaped labels as shown in Figures 1 and 3 of Warther. Eventhough, “Warther considers triangle shapes as difficult to remove from a scored sheet” as pointed out by Applicant, Warther nonetheless arranges triangular-shaped labels as shown in Figures 1 and 3 in order to maximize the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41). One of ordinary skill in the art is amply motivated to combine the references to arrive at a maximum number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size as taught by Warther.

How is it that “the only potential teaching for [the motivation for combining the references] is clearly Applicant’s own patent application”? Both Oosterlinck and Warther disclose labels, and Warther clearly teaches the arrangement of triangular-shaped labels as shown in Figures 1 and 3 in order to maximize the number of tag elements (equivalently labels, i.e. the labels taught by Oosterlinck) provided by a sheet product of a given size (col. 3, lines 33-41). Applicant’s assertion that “the only potential teaching for [the motivation for combining the references] is clearly Applicant’s own patent application” is not the case.

Art Unit: 1772

3. Applicant's arguments in Paper #8 regarding the 35 U.S.C. 103 rejection of claims 9, 21 and 23 made of record in Paper #5 and repeated in Paper #7 have been fully considered but are not persuasive. Applicant's arguments regarding the rejection to these claims rely entirely on the arguments against the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper #5 and repeated in Paper #7 addressed above.

4. Applicant's arguments in Paper #8 regarding the 35 U.S.C. 103 rejection of claims 10 and 12 made of record in Paper #5 and repeated in Paper #7 have been fully considered but are not persuasive. Applicant's arguments regarding the rejection to these claims rely entirely on the arguments against the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper #5 and repeated in Paper #7 addressed above.

5. Applicant's arguments in Paper #8 regarding the 35 U.S.C. 103 rejection of claims 13 and 14 made of record in Paper #5 and repeated in Paper #7 have been fully considered but are not persuasive. Applicant's arguments regarding the rejection to these claims rely entirely on the arguments against the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper #5 and repeated in Paper #7 addressed above.

6. Applicant's arguments in Paper #8 regarding the 35 U.S.C. 103 rejection of claims 15-18 made of record in Paper #7 have been fully considered but are not persuasive.

Applicant's arguments regarding the rejection to claims 15-18 rely in part on the arguments against the 35 U.S.C. 103 rejection of claims 1-7 made of record in Paper #5 and repeated in Paper #7 addressed above.

Applicant's assert that the Office Action "correctly notes" that "neither Oosterlinck, Warther, nor Kirk teach or suggest a triangular shaped label that has sides of equal length that is

Art Unit: 1772

also covered with a adhesive layer”. The Office Action does not say this. The Office Action says “Oosterlinck, Warther and Kirk fail to teach that the triangular shaped label has sides of equal length” (last two lines of page 3 of Paper #7). While Warther does not explicitly teach that the triangle has sides of equal length, Warther teaches that the tags (equivalently labels as discussed above) are triangular shaped. Warther teaches the maximization of the number of tags on a sheet product of a given size (col. 3, lines 33-41). The arrangement of the tags taught by Warther achieves maximization of number of tags on a sheet product of a given size as opposed to alternative arrangements as even those without ordinary skill in the art would recognize with routine experimentation, if not without. The fact that the goal of maximization of the number of tags on a sheet product of a given size is taught by Warther sufficiently motivates one of ordinary skill in the art to experiment with different triangle shapes, and consequently triangle sizes, to achieve maximization of the number of tags on a sheet product of a given size.

Examiner is not relying on personal knowledge as Applicant alleges, but is relying on what would be readily achieved via routine experimentation as motivated by Warther’s goal of maximization of the number of tags on a sheet product of a given size; therefore, an affidavit by Examiner as requested by Applicant is not warranted. Furthermore, it has been held that a modification involving a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

7. Applicant’s arguments in Paper #8 regarding the 35 U.S.C. 103 rejection of claims 21 and 23 made of record in Paper #5 and repeated in Paper #7 have been fully considered but are not persuasive. Applicant’s arguments regarding the rejection to these claims rely on the

Art Unit: 1772

arguments against the 35 U.S.C. 103 rejection of claims 1-7 and 15 made of record in Paper #5 and repeated in Paper #7 addressed above.


Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Friday from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba
06/23/03 WBA


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772 6/24/03